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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/269,874	08/02/1999	HERMANN BUJARD	402162000200	1745

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EXAMINER

FIELDS, IESHA P

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 11/20/2001

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/269,874

Applicant(s)

BUJARD ET AL.

Examiner

Iesha P Fields

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-82 is/are pending in the application.
- 4a) Of the above claim(s) 50-52 and 58-82 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 42-49 and 53-57 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Applicant's election with traverse of Group I Claims 42-49 and 53-57 (Paper Number 19) received on July 10, 2001 is acknowledged. The traversal is on the grounds that according to MPEP 803, if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. The argument that the restriction is improper because the application can be searched without serious burden is not found persuasive. It is the Examiner's position that it would be an undue burden to search all Groups as indicated by the divergent subject matter and different classification. For instance a search of the prior art to Group I would not reveal prior art of Groups II-VI as indicated by their different classification. Further with regards to the traversal on the ground that it would not be a serious burden to search all Groups it is the Examiner's position that the search for each of the above inventions is not co-extensive particularly with regard to the literature search. A reference that would anticipate the invention of one group would not necessarily anticipate or make obvious any of the other groups. Consequently, claims 42-82 are pending in the instant application, and claims 50-52 and 58-82 are withdrawn from further consideration.

The requirement is still deemed proper and is therefore made **FINAL**.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Claim Objections

1. Claims 42-49 and 53-57 are objected to because of the following informalities:
The claims recite an abbreviation ("AT" content). The applicant is required to spell the words in the claims.

Claim Rejections

Claim Rejections - 35 USC § 112

2. Claims 42-49 and 53-57 are rejected under 35 U.S.C. 112 first paragraph, as failing to provide an enabling disclosure without complete evidence that the claimed biological materials are known and readily available to the public or complete evidence of the deposit of biological materials.

The specification lacks complete deposit information for the deposit of vectors dPS56RBSII, pBi-5, ppTMCS and strains DH5alphaZ1 FCB-1.

It is not clear that the vectors and strains are known and publicly available or can be reproducibly isolated from nature without undue experimentation.

Exact replication of the vectors and strains are an unpredictable event. Although applicant has provided a written description of a method for making the claimed vectors

Art Unit: 1645

and strains, this method will not necessarily reproduce vectors and strains which are chemically and structurally identical to those claimed.

Because one skilled in the art could not be assured of the ability to practice the invention as claimed in the absence of the availability of vectors dPS56RBSII, pBi-5, ppTMCS and strains DH5alphaZ1 FCB-1, a suitable deposit for patent purposes, evidence of public availability of the vectors and strains and or evidence of the reproducibility without undue experimentation is required.

If the deposit has been made under the provisions of the Budapest Treaty, filing of an affidavit or declaration by applicant or assignees or a statement by an attorney of record who has authority and control over the conditions of deposit over his or her signature and registration number stating the deposit has been accepted by an International Depository Authority under the provisions of the Budapest Treaty, that all restrictions upon public access to the deposit will be irrevocably removed upon the grant of a patent on this application and that the deposit will be replaced if viable samples cannot be dispensed by the depository required. This requirement is necessary when deposits are made under the provisions of the Budapest Treaty as the Treaty leaves this specific matter to the discretion of each state. Amendment of the specification to recite the date of deposit and the completing the record, applicant may submit a copy of the contract with the deposit and maintenance of each deposit.

If the deposits have not been made under the provisions of the Budapest Treaty, then in order to certify that the deposits comply with the criteria set forth in 37 CFR § 1.801-1.809, assurances regarding availability and permanency of deposits are required. Such assurance may be in the form of an affidavit or declaration by applicants or assignees or in the form of a statement by an attorney of record who has the authority and control over the conditions of deposit over his or her signature and registration number averring:

(a) during the pendency of this application, access to the deposits will be afforded to the Commissioner upon request;

(b) all restrictions upon the availability to the public of the deposited biological material will be irrevocably removed upon the granting of a patent on this application;

(c) the deposits will be maintained in a public depository for a period of at least thirty years from the date of deposit or for the enforceable life of the patent or for a period of five years after the date of the most recent request for the furnishing of a sample of the deposited biological material, whichever is longest; and

Art Unit: 1645

(d) the deposits will be replaced if they should become nonviable or non-replicable.

In addition, a deposit of biological material that is capable of self-replication either directly or indirectly must be viable at the time of deposit and during the term of deposit. Viability may be tested by the depository. The test must conclude only that the deposited material is capable of reproduction. A viability statement for each deposit of a biological material not made under the Budapest Treaty must be filed in the application and must contain:

- 1) The name and address of the depository;
- 2) The name and address of the depositor;
- 3) The date of the deposit;
- 4) The identity of the deposit and the accession number given by the depository;
- 5) The date of the viability test;
- 6) The procedures used to obtain a sample if the test is not done by the depository; and
- 7) A statement that the deposit is capable of reproduction.

As a possible means for completing the record, applicant may submit a copy of the contact with the depository for deposit and maintenance of each deposit.

If the deposit was made after the effective filing date of the application for patent in the United States, a verified statement is required from a person in a position to corroborate that the vectors and strains described in the specification as filed is the same as that deposited in the depository. Corroboration may take the form of a showing of a chain of custody from applicant to the depository coupled with corroboration that the deposit is identical to the biological material described in the specification and in the applicant's possession at the time the application was filed.

Applicant's attention is directed to In re Lundack, 773 F. 2d. 1216, 227 USPQ 90 (CAFC 1985) and 37 CFR § 1.801-1.809 for further information concerning deposit practice.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1645

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 42-49 and 53-57 are rejected under 35 U.S.C. 102(b) or 103(a) as being unpatentable over Holder et al.

The claims are drawn to a method of producing the gp290/MSP1 protein of *Plasmodium*.

Holder et al. (Nature 1985 Vol. 317 pp 270-73) disclose a method of producing the gp290/MSP1 protein of *Plasmodium*. Holder et al. further disclose that the protein is derived from *Plasmodium falciparum*. Although Holder et al. does not state that the AT content of the expressed nucleotide sequence encoding the gp290/MSP1 protein is less

Art Unit: 1645

than the AT content of a naturally occurring nucleotide sequence, the overall structure and function of the protein is being viewed as the same. The burden is on the applicant to show and unobvious distinction between the material structural and functional characteristics of the claimed product and the product of the prior art.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Iesha P Fields whose telephone number is (703) 605-1208. The examiner can normally be reached on 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (703) 308-3909. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Iesha Fields

November 19, 2001


MARK NAVARRO
PRIMARY EXAMINER